



1 for 2835

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Walter Fix et al.
SERIAL NO: 10/524,646
FILED: February 17, 2005
FOR: Organic Component for Overvoltage Protection and Associated Circuit
EXAMINER: Anatoly Vortman ART UNIT: 2835
Customer No. 27162
ATTORNEY DOCKET: 411000-127

NOTICE OF INCOMPLETE OFFICE ACTION
REQUEST FOR WITHDRAWAL OF ACTION AND A NEW ACTION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

SIR:

This paper is in regard to an Office Action dated October 19, 2007 in the above-entitled application, and in particular, to the Information Disclosure Statement which was not fully considered by the Office. This non-consideration of the cited references is error, results in the Action being incomplete and therefore, it is requested that the Action be withdrawn and a new Action issued with all relevant cited references considered.

On Nov. 15, 2007, applicants' undersigned attorney called the Examiner about this matter. The Examiner refused to take any action at this time to consider all of the applicable references in view of applicants' attorney explaining the below as to the need for correction in this matter. The Examiner stated that applicants can provide the below presented discussion in their response to the Office Action. However, this is not correct timing.

If the Examiner agrees to review such references after a response is filed and finds a cited reference to be pertinent to the claims, it is possible for the PTO to issue a final rejection based on this reference under a new grounds of rejection. This is improper if such a reference should be cited now. Therefore, the present Action is

incomplete, should be withdrawn and replaced by a new Action considering all of the applicable cited references.

As a result applicants respectfully request that the present Office Action be withdrawn and a new Action submitted and a new date for response set. The new Action should consider all of the relevant IDS cited references not presently considered.

For example, various foreign references and International applications for which English translations in toto or in their abstracts, that have been provided, are not considered such as IDS items 14-19, 33-35, 37-38, 50-52, 56, 63-66, 68, 72-74, numerous ones of the references on the pages with items 81-92, 94-103, almost all NPL items starting at items 106-162 which are in English, US pending applications items 127 -141, obviously in English, numerous items on pages 3-5 and the NPL items of the disclosure statement filed 9/26/05, the Japanese reference with an English portion in the disclosure statement filed 10/31/05, and the US pending applications in the disclosure statement filed May 24, 2007. All of the English language documents or abstracts in English, are required to be considered as no citation of relevancy is required by the rules and there is no rule cited by the Action that limits the number of documents which may be submitted in an IDS, the Action complaining of the numerous documents cited.

The Action refers to numerous references not in the English language as the reason for not considering. But contrary to this statement, numerous references in the English language are not considered. This is error.

The Action states that information pertaining to published US patent documents has been considered. This is not true and improper. Commonly owned applications that were published were not considered. For example, per the PTO Pair system, item 127 in the IDS, US 10/524,646, was published on 5/11/06. Item 128, application 10/533,756, item 129 10/534,678, and item 131, 10/535,448 were published on 6/8/06, item 132, 10/535,449 was published on 2/16/06 and so on. This lack of consideration of the cited US published references is a clear violation of the rules, the MPEP and PTO policy.

Enclosed is a copy of the USPTO OG notice of 19 Oct 2004 1287 OG 163 cited in the MPEP 609.04(a) II Legible Copies (copy also enclosed) where copies of cited pending US applications is waived. In addition, per MPEP 609.04(a) III "Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation." (copy enclosed) Many of the foreign language cited references have an English abstract and thus should have been considered.

The Action states that some of the cited references are not material to patentability. This statement misconstrues applicants' duty as they presently understand from the rules and the MPEP. MPEP 2004, page 2000-9, paragraph 10, copy enclosed, states that "When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided." Citing case. "In short, the question of relevancy in close cases, should be left to the examiner and not the applicant." Citing case. Applicant has cited references that were cited in the copending applications or commonly owned patents including patents cited in foreign counterpart applications.

The Action states that where applicants are aware of any cited reference from among the cited references in the IDS, applicants should make that reference known to the examiner. Applicants have done that. They cited the international search report with specific references cited as well as the Written Opinion of the International Search Authority. Applicants are not aware of the pertinence of any of the other cited references.

In a disclosure statement filed with the application, applicants cited copending applications which are commonly owned wherein there may be one or more common inventors. These were cited, as explained therein, in that these applications relate in different respects to organic electronic devices and/or method of making these devices such as transistors, diodes, integrated circuits and the like. Therefore, cited references relating to these applications may also have related information to the various technologies disclosed. Applicants are not aware of the materiality of any of the cited references other than as given in the corresponding IDS.

The Action cites *In re Multidistrict-Litig.* However, this case relates to fraud relating to the failure to report to the examiner the results of certain experiments carried out, and not with respect to any information disclosure irregularities, and thus is irrelevant to the issue of applicants' IDSs.

The Action also attempts to bootstrap applicants' good faith disclosure of various references cited in the copending applications or their counterparts into an inference of possible inequitable conduct, which is counterproductive. Applicants in good faith attempt to cite references which might have some relevance to the present application and the Action bootstraps this good faith effort into an insinuation of bad faith by citing cases such as *J.P. Stevens* and the like. This is inappropriate and improper. These cited cases are not relevant to the issue of IDSs or their contents. For example, the Action cites *Multidistrict-Litig.* stating "it is 'material if it [submission] makes it impossible for the Patent Office fairly assess [the patent] application against the prevailing statutory criteria.' " Then the Action indicates that the citation of 340 documents "make it difficult and likely impossible for the Patent Office to fairly assess Applicants' application against the prevailing statutory criteria." Applicants disagree. Applicants have cited similar IDSs in the other copending applications cited by applicants. The examiners have indicated that they have considered the cited references without objection. In some cases the examiners have cited an IDS cited reference, from the numerous cited references, against the claims at issue in the relevant application, thus providing evidence that the citation of the references has not made it difficult or impossible for the PTO to fairly assess the relevant application against the prevailing statutory criteria and, indeed, have found a reference so cited, material to the relevant application.

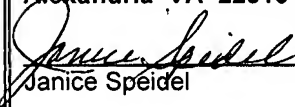
Monsanto cited in this regard, also is irrelevant to the citation of references in an IDS. This case is about fraud where less than 25% of test results were reported to the PTO, 150 test results of 810. The district court concluded that the close cropping of the findings amounted to misrepresentation and was affirmed on appeal. This has nothing to do with IDSs, but express misrepresentation of test result facts related to patentability issues.

Submitting an IDS with references that may be relevant is not a misrepresentation according to the cited cases and is made in compliance with 37 CFR 1.56 duty. As the MPEP states, applicant should not substitute his judgment for that of the examiner. To bootstrap this duty to disclose into an inference of fraudulent misrepresentation by the Office tends to discourage candor by an applicant as to all references that might be relevant and is contrary to PTO policy and the rules as discussed above.

The undersigned is aware of countless patents where numerous patents have been cited in IDSs and have been considered by the examiners and the references printed in the issued patent. Applicants find the approach of the Action in the instant case extraordinary, improper and should be withdrawn. While applicants regret any inconvenience to the Examiner in reviewing the cited documents, applicants believe they did so in compliance with the MPEP and the present rules.

For these reasons, the Action is in error in not considering the cited English language references including English language abstracts, should be withdrawn and a new Action provided with a new date for response set.

While no fee is believed due for this paper, the Commissioner is authorized to charge any fees due for this paper or credit any overpayment to Deposit Account 030678.

FIRST CLASS CERTIFICATE	
I hereby certify that this correspondence is being deposited on the date set forth below with the U.S. Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:	
Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	
 Janice Speidel	November 16, 2007 Date

332359v1

Respectfully submitted,
Walter Fix et al.

by: 
William Squire, Reg. No. 25,378
Attorney for Applicants

CARELLA, BYRNE, BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN
5 Becker Farm Road
Roseland, NJ 07068
Tel. No.: (973) 994-1700
Fax No. (973) 994-1744

United States Patent and Trademark Office OG Notices: 19 October 2004

Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications

37 CFR 1.98 requires that for each cited pending U.S. patent application, an information disclosure statement (IDS) include a legible copy of the application specification, including the claims, and any drawing of the application, or that portion of the application which caused it to be listed, including any claims, directed to that portion. See 37 CFR 1.98(a)(2)(iii).

The United States Patent and Trademark Office (USPTO) has been scanning newly filed patent applications and the existing inventory of patent applications into USPTO's Image File Wrapper (IFW) system since June of 2003. See Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003). Applications stored in the IFW system may be viewed by examiners on their desktop computers. Consequently, there is no longer a need to require a copy of the specification, including claims, and drawings of a U.S. patent application (or portion of the application) listed on an IDS when the cited application is stored in the USPTO's IFW system, and can be readily viewed by examiners, applicants and members of the public.

Therefore, the requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is sua sponte waived where the cited pending application is stored in the USPTO's IFW system. See 37 CFR 1.183. This waiver is effective immediately.

Applications filed under 35 U.S.C. 111 on or after June 30, 2003, and international applications that have entered the national stage on or after June 30, 2003, have been or are being scanned into the USPTO's IFW system. When citing to a pending application filed under 35 U.S.C. 111 before June 30, 2003, or that entered the national stage before June 30, 2003, the applicant may check the private Patent Application Information Retrieval (PAIR) System to see whether the application is stored in the USPTO's IFW system in order to determine if a copy of the application (or portion of the application) is required to be provided with an IDS. The private PAIR System can be accessed over the Office's Internet Web site (www.uspto.gov).

When citing to a pending U.S. patent application that has been published under 35 U.S.C. 122(b) (eighteen-month publication), the USPTO prefers that the citation be to the patent application publication (by publication number) rather than to the application itself (by application number).

This waiver is limited to the specification, including the claims, and drawings in the U.S. application (or portion of the application). If material other than the specification, including the claims, and drawings in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material. See 37 CFR 1.98(a)(1)(iv).

Inquiries concerning this notice may be directed to Jeanne M. Clark,
Senior Legal Advisor, Office of Patent Legal Administration, at
(703) 306-5603.

STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy

published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published. Pending U.S. applications that are being cited can be listed under the non-patent literature section or in a new section appropriately labeled.

The list of information complying with the format requirements of 37 CFR 1.98(a)(1) and the identification requirements of 37 CFR 1.98(b) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO/SB/08A and 08B, Information Disclosure Statement, to list the documents is encouraged.

II. LEGIBLE COPIES

In addition to the list of information, each information disclosure statement must also include a legible copy of:

- (A) Each foreign patent document;
- (B) Each publication or that portion which caused it to be listed;
- (C) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless

the cited pending U.S. application is stored in the Image File Wrapper (IFW) system. The requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is sua sponte waived where the cited pending application is stored in the USPTO's IFW system. See Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications, 1287 O.G. 163 (Oct. 19, 2004); and

(D) All other information or that portion which caused it to be listed.

The requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS, has been eliminated, unless required by the Office. 37 CFR 1.98(a)(2).

37 CFR 1.98(a)(2)(iii) requires a copy of a pending U.S. application that is being cited in an IDS if (A) the cited information is not part of the specification, including the claims, and the drawings (e.g., an Office Action, remarks in an amendment paper, etc.), or (B) the cited application is not stored in the USPTO's IFW system. The requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is sua sponte waived where the cited pending application is stored in the USPTO's IFW system. A pending U.S. application only identified in the specification's background information rather than being cited separately on an IDS listing is not part of an IDS submission. Therefore, the requirements of 37 CFR 1.98(a)(2)(iii) of supplying a copy of the pending application is not applicable. Pursuant to 37 CFR 1.98(a)(2)(iii), applicant may choose to cite only a portion of a pending application including any claims directed to that portion rather than the entire application.

There are exceptions to this requirement that a copy of the information must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (A) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an

earlier filing date under 35 U.S.C. 120; and (B) the IDS submitted in the earlier application complies with 37 CFR 1.98(a)-(c). If both of these conditions are met, the examiner will consider the information previously cited or submitted to the Office and considered by the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See subsection III. below.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form ** PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted)).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the exam-

iner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

Electronic means or medium for filing IDSs are not permitted except for: (A) citations to U.S. patents and U.S. patent application publications in an IDS filed via the Office's Electronic Filing System (EFS) (see MPEP § 609.07); or (B) a compact disc (CD) that has tables, sequence listings, or program listings included in a paper IDS in compliance with 37 CFR 1.52(e). A CD cannot be used to submit an IDS listing or copies of the documents cited in the IDS.

III. CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or part of the specification. If the concise explanation is part of the specification, the IDS listing should include the page(s) or line(s) numbers where the concise explanation is located in the specification.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but

7. Care should be taken to see that prior art or other information cited in a specification or in an information disclosure statement is properly described and that the information is not incorrectly or incompletely characterized. It is particularly important for an attorney or agent to review, before filing, an application which was prepared by someone else, e.g., a foreign application. It is also important that an attorney or agent make sure that foreign clients, including foreign applicants, attorneys, and agents understand the requirements of the duty of disclosure, and that the U.S. attorney or agent review any information disclosure statements or citations to ensure that compliance with 37 CFR 1.56 is present. See *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 54 USPQ2d 1001 (Fed. Cir. 2000). During prosecution patentee submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The untranslated portions of the Japanese reference "contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO." 204 F.3d at 1374, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. "The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner's attention from the reference's relevant teaching." 204 F.3d at 1378, 54 USPQ2d at 1008. See also *Gemveto Jewelry Co. v. Lambert Bros., Inc.*, 542 F. Supp. 933, 216 USPQ 976 (S.D.N.Y. 1982) wherein a patent was held invalid or unenforceable because patentee's foreign counsel did not disclose to patentee's United States counsel or to the Office prior art cited by the Dutch Patent Office in connection with the patentee's corresponding Dutch application. The court stated, 542 F. Supp. at 943, 216 USPQ at 985:

Foreign patent attorneys representing applicants for U.S. patents through local correspondent firms surely must be held to the same standards of conduct which apply to their American counterparts: a double standard of accountability would allow foreign attorneys and their clients to escape responsibility for fraud or inequitable conduct merely by withholding from the local correspondent

information unfavorable to patentability and claiming ignorance of United States disclosure requirements.

8. Care should be taken to see that inaccurate statements or inaccurate experiments are not introduced into the specification, either inadvertently or intentionally. For example, stating that an experiment "was run" or "was conducted" when in fact the experiment was not run or conducted is a misrepresentation of the facts. No results should be represented as actual results unless they have actually been achieved. Paper >or prophetic< examples should not be described using the past tense. *>*Hoffman-La Roche, Inc. v. Promega Corp.*, 323 F.3d 1354, 1367, 66 USPQ2d 1385, 1394 (Fed. Cir. 2003); see also< MPEP § 608.01(p) and § 707.07(l). Also, misrepresentations can occur when experiments which were run or conducted are inaccurately reported in the specification, e.g., an experiment is changed by leaving out one or more ingredients. See *Steierman v. Connelly*, 192 USPQ 433 (Bd. Pat. Int. 1975); 192 USPQ 446 (Bd. Pat. Int. 1976).

9. Do not rely on the examiner of a particular application to be aware of other applications belonging to the same applicant or assignee. It is desirable to call such applications to the attention of the examiner even if there is only a question that they might be "material to patentability" of the application the examiner is considering. >See *Dayco Prod., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1365-69, 66 USPQ2d 1801, 1806-08 (Fed. Cir. 2003) (contrary decision of another examiner reviewing substantially similar claims is 'material'; copending application may be 'material' even though it cannot result in a shorter patent term, when it could affect the rights of the patentee to assign the issued patents).< It is desirable to be particularly careful that prior art or other information in one application is cited to the examiner in other applications to which it would be material. Do not assume that an examiner will necessarily remember, when examining a particular application, other applications which the examiner is examining, or has examined. **>A "lapse on the part of the examiner does not excuse the applicant."< *Kanga-ROOS U.S.A., Inc. v. Caldor, Inc.*, 778 F.2d 1571, 1576, 228 USPQ 32, 35 (Fed. Cir. 1985)**>; see also MPEP § 2001.06(b).<

10. When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or

applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided. The court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) stated "In short, the question of relevancy in close cases, should be left to the examiner and not the applicant." See also *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).

11. It may be desirable to submit information about prior uses and sales even if it appears that they may have been experimental, not involve the specifically claimed invention, or not encompass a completed invention. See *Hycor Corp. v. The Schlueter Co.*, 740 F.2d 1529, 1534-37, 222 USPQ 553, 557-559 (Fed. Cir. 1984). See also *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).

12. Submit information promptly. An applicant, attorney, or agent who is aware of prior art or other information and its significance should submit same early in prosecution, e.g., before the first action by the examiner, and not wait until after allowance. Potentially material information discovered late in the prosecution should be immediately submitted. That the issue fee has been paid is no reason or excuse for failing to submit information. See *Elmwood Liquid Products, Inc. v. Singleton Packing Corp.*, 328 F. Supp. 974, 170 USPQ 398 (M.D. Fla. 1971).

13. It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

14. Watch out for continuation-in-part applications where intervening material information or documents may exist; particularly watch out for foreign patents and publications related to the parent application and dated more than 1 year before the filing date of the CIP. These and other intervening documents may be material information. See *In re Ruscetta*, 255 F.2d

687, 690-91, 118 USPQ 101, 104 (CCPA 1958); *In re van *Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972); *Chromalloy American Corp. v. Alloy Surfaces Co.*, 339 F. Supp. 859, 173 USPQ 295 (D. Del. 1972).

15. Watch out for information that might be deemed to be prior art under 35 U.S.C. 102(f) and (g).

Prior art under 35 U.S.C. 102(f) may be available under 35 U.S.C. 103. See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1401, 43 USPQ2d 1641, 1644 (Fed. Cir. 1997)(35 U.S.C. "102(f) is a prior art provision for purposes of § 103"); *Dale Electronics v. R.C.L. Electronics*, 488 F.2d 382, 386, 180 USPQ 225, 227 (1st Cir. 1973); and *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. App. 1981).

Note also that evidence of prior invention under 35 U.S.C. 102(g) may be available under 35 U.S.C. 103, such as in *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973).

Note 35 U.S.C. 103(c) disqualifies 35 U.S.C. 102(f)/103 or 102(g)/103 prior art which was, at the time the second invention was made, owned by or subject to an obligation of assignment to, the person who owned the first invention. Further note that 35 U.S.C. 103(c) disqualifies 35 U.S.C. 102(e)/103 prior art for applications filed on or after November 29, 1999. See MPEP § 706.02(l) - § 706.02(l)(2).

16. Watch out for information picked up by the inventors and others at conventions, plant visits, in-house reviews, etc. See, for example, *Dale Electronics v. R.C.L. Electronics*, 488 F.2d 382, 386-87, 180 USPQ 225, 228 (1st Cir. 1973).

17. Make sure that all of the individuals who are subject to the duty of disclosure, such as spelled out in 37 CFR 1.56, are informed of and fulfill their duty.

18. Finally, if information was specifically considered and discarded as not material, this fact might be recorded in an attorney's file or applicant's file, including the reason for discarding it. If judgment might have been bad or something might have been overlooked inadvertently, a note made at the time of evaluation might be an invaluable aid in explaining that the mistake was honest and excusable. Though such records are not required, they could be helpful in recalling and explaining actions in the event of a question of "fraud" or "inequitable conduct" raised at a later time.